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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,988	04/21/2004	Norton Spiel	240314 Spiel Combo Con2	6920

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EXAMINER	
CADUGAN, ERICA E	

ART UNIT	PAPER NUMBER
3722	

MAIL DATE	DELIVERY MODE
10/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/828,988	SPIEL, NORTON	
	Examiner	Art Unit	
	Erica E. Cadugan	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-38* is/are pending in the application.

4a) Of the above claim(s) *21-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/7/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Claims 21-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 10, 2007.

Terminal Disclaimer

3. The terminal disclaimers filed on March 7, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration dates of U.S. Pat. No. 6,547,502 and U.S. Pat. No. 6,726,426 have been reviewed and are accepted. The terminal disclaimers have been recorded.

Claim Objections

4. Claims 31-38 are objected to because of the following informalities: throughout the claims, the terms "coils segments" and "coil segments" are used apparently interchangeably. For example, see claim 31, line 6 ("said coils segments") and line 8 ("said coil segments"), though it is noted that these are by no means the only such occurrences. For consistency and clarity, it appears that the same term (of these two terms) should be used throughout the claims; i.e., it appears that either all of the instances of "said coils segments" should be changed to --said coil segments-- or all of the instances of "said coil segments" should be changed to --said coils segments--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 31-38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Re claim 31, claim 31 sets forth the step of transferring coil segments to a binding machine... "so that an elapsed time between when coils segments are cut and said coil segments arrive at said binding machine is sufficient to allow said coils segments to cool slowly and adequately for proper processing by said binding machine". However, the specification as originally filed does not provide guidance to enable one skilled in the art to make or use this invention, and particularly to do so without undue experimentation. Note that the specification does not teach or provide guidance as to what is meant by a "sufficient" elapsed time, nor what is meant by "slow" and "adequate" cooling, nor particularly what counts as such as it relates to any sort of "proper" processing as claimed.

Note further that no specific "plastic" material is claimed, and what is considered "slow" and "adequate" cooling for one type of plastic might not be so considered for another type of plastic, particularly noting that there are many, many varieties of plastics, each with their own set of different properties. Note that even if a particular type of plastic is put into the claims, such as polyvinylchloride or PVC, that this still does not address the issue of any quantification of what

is considered "slow" and "adequate" cooling for such, noting that no quantification of any desired properties of such material have been set forth, for example.

Note also that the specification (nor the claims) does not quantify in any way what constitutes "slow and adequate" cooling, nor any particular amount of "elapsed time" for achieving such. No desired temperature (either starting or ending) is set forth, no length of a conveyor belt, and particularly no length of conveyor belt related to any speed of such a conveyor that would be translatable into any particular amount of elapsed time of conveyance is set forth.

Note also that the specification (nor the claims) does not quantify any particular properties of the coil segments to define a coil segment that has been cooled "slowly and adequately for proper processing", such as any desired quantified hardness or elasticity, other than to imply that a "brittle" coil segment is undesirable. However, the specification doesn't provide any requisite standard or quantifiable property for enabling one to determine what constitutes "brittle", such that this still doesn't serve to provide enabling disclosure for determining what is meant by allowing the coil segments to "cool slowly and adequately for proper processing..." as claimed.

7. Claims 31-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 31-38 are replete with instances that do not particularly point out and distinctly claim the subject matter of applicant's invention. Examples of these instances are listed below,

but these instances are not limited to the listed examples. Applicant is advised to closely review the claims for other occurrences.

The terms "sufficient" (referring to an "elapsed time"), in claim 31, line 8, and "slowly" and "adequately", and particularly "slowly and adequately for proper processing", in claim 31, line 9, are relative terms which render the claims indefinite. The terms "sufficient" (referring to an "elapsed time"), in claim 31, line 8, and "slowly" and "adequately", and particularly "slowly and adequately for proper processing", in claim 31, line 9, are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For further explanation, see also the above rejection of claim 31 under 35 USC 112, first paragraph.

There are several positively recited limitations that lack sufficient antecedent bases in the claims. A few examples of this are: "said coils" in claim 32, line 1, and in claim 33, line 1 (previously referred to were plural coil "segments"); "said binding coils" in claim 34, line 2 (again, previously referred to were plural coil "segments"); "said plastic spiral forming machine" in claim 36, line 2 (previously, "coil forming machine"); "said transfer mechanism" in claim 36, line 7; and "said motor" in claim 37, line 5. This is not meant to be an all-inclusive list of such occurrences. Applicant is required to review the claims and correct any other such occurrences of limitations lacking sufficient antecedent basis.

For consistency and clarity, it appears in claim 35, penultimate line, that "said plastic coil" should be changed to --said plastic coils segments-- or --said plastic coil segments--. Similarly, claims 36, plus, set forth "said spiral coil", "said plastic spiral", "said spiral coils",

etc., all to apparently refer to the same structure, and possibly to refer to the same structure already claimed as soil "segments". Consistency in claim terminology should be used for clarity.

Claim 36 sets forth the limitation of "discharging said heated plastic thread in free air as a heated spiral coil by cutting said heated plastic thread to a predetermined size as a heated coil and transferring said heated coil to said transfer mechanism". However, it is unclear as set forth in the claim how the cutting serves to "discharge" the heated plastic thread in free air.., i.e., noting the claim sets forth "discharging said heated plastic thread in free air... by cutting..." (As a side note, note that page 30, lines 20-24 teach that the spiral coil 513 emerges in free air from mandrel 512, and Figure 22 show that the spiral coil 513 that is in free air does not get cut until it reaches the cutter 514, which is after the "free air" described on page 30, lines 20-24).

Claim 37, line 1, sets forth "[T]he combination plastic spiral coil forming and binding machine as in claim 36...". However, claim 36 was directed to a "method", rather than a "combination plastic spiral coil forming and binding machine...", and thus, it is unclear what limitations from claim 36 are intended to be incorporated into claim 37. For the sake of expediting patent prosecution, and as best understood, with respect to the prior art, Examiner is treating claim 37 as though it instead read "[T]he method of claim 36...". However, appropriate correction is required.

In claim 37, it is unclear as claimed to what claim elements the "next vane" is associated with, i.e., a "next vane" of what, particularly noting that no previous "vane" has been claimed in order to understand what is meant by a "next" one.

Claim Rejections - 35 USC § 102/103

8. Claims 31-34, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 3,688,809 to Negro, or in the alternative, are rejected under 35 U.S.C. 103 as being obvious over, U.S. Pat. No. 3,688,809 to Negro in view of U.S. Pat. No. 4,249,278 to Pfaffle.

Negro teaches a system and method for "forming" a coil 13 (see at least Figures 1 and 5-7) out of a wire comprising a plastic coating (which meets the claim language) or out of a thread of synthetic material, which would apparently be a plastic material (see at least col. 4, lines 32-37) using a generic winding device 11 (see col. 4, lines 37-38, which expressly teaches that the winding device 11 "may be of any construction whatever). The coil 13 is cut into a discrete "coil segment" 13' via cutting tool 17 (see Figures 1, 5-7), which is then conveyed or "transferred" to a threading station 30, considered the claimed "binding machine", wherein the discrete coil segments 13' are threaded or "inserted" into holes 32 of a stack of sheets 31 to be bound (see at least Figures 5-7 and col. 5, lines 25-27, for example).

It is considered to be inherent that the thread/wire heats at least somewhat upon being wound or formed in the winding device 11 due to the frictional contact of the thread/wire with the forming tooling.

It is further considered inherent that during the time frame between when the coil 13 exits the winding device 11 into ambient air and when it enters into the "binding machine" 30, the coil 13 and coil segments 13', by virtue of their presence in the ambient air after exiting the winding device 11, will cool at least to some degree. It is further considered to be inherent that such cooling is adequate for "proper processing" by the "binding machine" 30, or else the binding

machine 30 would not be able to function properly to produce bound objects, which would rather defeat the purpose of Negro's invention.

Re claim 32, as broadly claimed, note that at the very least, any of the embodiments shown in Figures 5-7 can be considered to teach the advancement of the coil segments 13' towards the "binding machine" in "incremental steps". For example, in Figure 5, note that the coil segment 13', after being cut by cutting tool 17, is rotated about an axis extending perpendicularly to the paper by 180 degrees in one "incremental step", and is moved (vertically with respect to the orientation shown in Figure 5) in another "incremental step" towards the binding machine 30, and is then moved to the right (with respect to Figure 5) in another "incremental step" towards the binding machine 30. Similar incremental movement steps occur in the embodiments of Figures 6 and 7. See at least Figures 5-7, as well as col. 5, line 11 through col. 6, line 17, for example. Note that this is only one possible interpretation of the limitation "incremental step", but that it is not the only possible interpretation, noting at least the teachings of col. 6, lines 4-7, for example, which describes operating "cycles", i.e., "incremental steps".

Re claim 33, it is noted that whatever structure serves to "convey" the segments 13' (as shown in at least Figures 5-7 and described in at least col. 5, lines 25-27, for example) constitutes the claimed "linkage cooling conveyor" as broadly claimed. Note that any such structure performs the indicated "transferring" or "conveying", that such "transferring" or "conveying" inherently provides further time out of the winding device 11, which inherently enables the segments 13' to cool as described previously, and such structure "links" the winding device 11 with the binding machine 30.

Re claim 34, see Figures 5-7, noting that the transferring steps described above with respect to claim 32 are incremental and are at least thus considered "intermittent" as broadly claimed. Alternatively re claim 34, see the embodiment of Figure 7, and the description thereof in at least col. 5, line 58 through col. 6, line 17, noting the coils are "intermittently" advanced into and from the magazine 39, for example.

In the alternative, in the event that it is determined that the plastic-coated wire or the "synthetic" thread teachings are not an explicit teaching of forming a "plastic" spiral coil, then it is noted that Pfaffle explicitly teaches that "[P]lastic spiral binders for sheet groups have certain advantages over metal spiral binders in terms of resistance to damage, particularly in cases where the ends of two binders are accidentally hooked together" (see col. 1, lines 10-16, for example, in the Pfaffle reference).

Thus, particularly in light of Negro's teachings of various materials and particularly "synthetic materials" (noting that plastic is a synthetic material), it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the "plastic" material taught by Pfaffle for the synthetic material (or even for the "wire" material taught by Negro in view of Pfaffle's teachings of the problems associated with metal spirals) taught by Negro for the purpose of providing a spiral that provides the advantage of damage resistance, particularly in cases where the ends of two binders are accidentally hooked together, as taught by Pfaffle (col. 1, lines 10-16, for example).

Claim Rejections - 35 USC § 103

9. Claim 35, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,688,809 to Negro as applied to at least claims 31 and 33-34 above.

Negro teaches all aspects of the presently-claimed invention as set forth above, but is silent as to the specific configuration of the conveyor used, and thus does not teach the drive pulley, gear motor, and speed controller of claim 35.

However, Examiner takes Official Notice that the use of a conveyor wherein a motor speed controller electrically connected to a gear motor causes a drive pulley communicating with and advancing a conveyor driven by said gear motor to intermittently rotate and advance a product carried on the conveyor is a well-known conveyor configuration utilized for transporting goods in a well-defined and precision timed manner in a manufacturing environment.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the specific well-known arrangement of conveyor claimed for the generic conveyor taught by Negro, such as in the embodiment in Figure 6, to convey the spirals 13' in direction 38 from the upper to the lower position shown (upper and lower are with respect to Figure 6), for the purpose of providing a well-known precision conveyor that is easily capable of performing precision timing to convey the spirals from one production machine area (i.e., winding machine 11) towards another production area (i.e., towards binding machine 30).

10. Claim 36, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 3,688,809 to Negro in view of U.S. Pat. No. 4,249,278 to Pfaffle.

Negro teaches all aspects of the presently-claimed invention as set forth above. Further note that the winding machine 11 operates in-line with the binding machine 30, and thus are considered to operate at "compatible speeds", and also note that the winding machine 11 serves to discharge the heated spiral 13 into "free air" at area 40 (see Figures 5-7, for example) (note

also the spacing between winding machine 11 and guide element 15, i.e., "free air"). Additionally, re the claimed "receiving conveyor" of the binding machine, note that the rollers 33, 34 serve to "receive" and "convey" the spiral 13' into the holes 32 as broadly claimed.

However, Negro generically teaches the winding machine 11, and does not teach specifics thereof, and thus, does not teach the thread being taken from a "spool", being "preheated" in a "heating chamber" and then advanced to and wound on a "mandrel" as set forth in claim 36.

However, Pfaffle teaches an automatic plastic spiral winding device wherein the plastic thread 33 is fed from a spool 34 into a "heating chamber" (46 is the heating element housing, 44 is the heating section, either can be considered the claimed "heating chamber"), where it is advanced and wound onto a "mandrel" 24 to form a plastic spiral coil member (see Figure 1 and col. 2, line 38 through col. 3, line 5, for example).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the winding device in its entirety as taught by Pfaffle for the winding device 11 taught by Negro for the purpose of enabling plastic to be readily formed (as taught by Pfaffle, see at least col. 1, lines 23-27 and col. 2, line 54 through col. 3, line 5), as well as for the purpose of providing a winding machine that is "relatively simple and easy to construct and is reliable and economical in operation" as explicitly taught by Pfaffle (col. 1, lines 46-49) (particularly since it appears that the cutting and binding structure taught by Pfaffle is generic and not critical to Pfaffle's invention, i.e., that Pfaffle's winding device can be used with other desired cutting and binding structures, see at least col. 3, lines 49-59, for example).

Note also that the present specification, on at least page 31, lines 18-24, teaches the following:

> While Figure 22 shows the movement of coils by cooling conveyor 525 at ambient air temperature, other cooling methods known to those skilled in the art may be used to cool coils 515 while coils 515 advance toward receiving conveyor 300, such as by exposure of the coils 517 to pressurized blasts of compressed air, by exposure to coils 518 to conventional cooling chambers cooled by freon filled conduits or other refrigeration means.

Note that according to at least this teaching in the present specification, exposure of the spiral coils to pressurized blasts of air or other cooling structure would appear to constitute the claimed allowing of the coils segments to "cool slowly and adequately for proper processing by said binding machine", and thus, for **at least** this reasoning, the claim language relating to the coil segments cooling "slowing and adequately..." does not serve to define over the teachings in the Pfaffle reference of the cooling chamber 52 and cooling section 45 having cooled air supplied thereto in order to cool the coils before they are ejected from the winding device into "free air", (where, i.e., in the free air, it is noted they would inherently also continue to cool).

Comment Re Claims 37-38

11. Regarding claims 37-38, it is noted that at this time, no rejection of the claims over the prior art is being made. However, in light of the rejections of these claims based on 35 USC 112, first paragraph, no indication regarding the allowability of these claims can be made at this time, pending the manner in which the issues with respect to at least 35 USC 112, first paragraph are resolved.

Response to Arguments

12. Most of Applicant's arguments (filed March 7, 2006) with respect to the elected claims 31-38 have been considered but are moot in view of the new ground(s) of rejection. Examiner will address any arguments to the extent that they are considered to apply.

Examiner notes that Applicant appears to primarily be asserting that the provision of the language in the claims relating to allowing the coils segments to "cool slowly and adequately for proper processing by said binding machine" serves to distinguish the claims from the prior art.

However, firstly, attention is directed to the above rejection under 35 USC 112, first (and second) paragraph of claims 31-38 that specifically addresses this claim language. Secondly, regarding the Negro and Pfaffle references, it is noted that different rejections are being applied to the new claims than were previously applied to the old claims, and Applicant's attention is directed to those new art rejections above, which serve to address these limitations in detail.

Additionally, Applicant has made a number of comments regarding the Gateway Protest filed 6/21/2005, which was denied entry into the application file, as set forth in detail in the decision on the protest mailed September 28, 2007. However, Applicant has now cited the Protest on the Information Disclosure Statement (IDS) submitted March 7, 2006, and as such, the document has been considered by the Examiner, as any other properly cited reference would be.

The comments (by either Applicant or the protester) regarding the claims (or the validity thereof) in U.S. Pat. No.'s 6,726,426 and 6,547,502 are not relevant to the prosecution of the present claims 31-38, noting that the present claims 31-38 are not identical to the claims in '426 and '502, and furthermore, noting that under 35 USC 282, a patent shall be presumed valid.

The comments regarding any language relating to "brittleness" or a "solid, non-brittle state" do not appear to be relevant to the present claim language as no such term or terms appear in present claims 31-38. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, in this case, it is noted that care should be taken if entering any such terms into the claims, as the term "brittle" is a relative term, and the specification does not appear to provide a standard for determining the requisite degree, i.e., there has been no quantification of any sort of how brittle constitutes "brittle".

Regarding Applicant's assertions regarding the various depositions cited in the IDS of 3/7/2006, it is noted that the various conflicting opinions expressed in the various depositions are considered as opinions, and do not carry the weight of factual evidence. If Applicant is attempting to assert that secondary considerations, such as failure of others to solve a problem, are present to overcome a rejection under 35 USC 103 over the Pfaffle reference (noting that such arguments are not relevant with respect to any rejection under 35 USC 102), then it is noted that Applicant has not provided sufficient factual evidence in support of this position, again noting the conflicting opinions as to the workability of Pfaffle's device stated in some of the art cited by Applicant, and again noting that all U.S. Patents, including Pfaffle, have a presumption of validity under 35 USC 282.

Furthermore, it is noted that any such evidence of secondary considerations must be tied to the language that is actually present in the claims, which does not appear to have occurred here.

Applicant's comments regarding any issue with respect to the "best mode" of the invention being disclosed do not appear to be relevant as no rejection of the claims under 35 USC 112, first paragraph, for failing to provide the best mode has been made in the case.

Regarding Applicant's comments re the Negro reference (U.S. Pat. No. 3,688,809) and whether it teaches heating and/or cooling, Applicant's attention is directed to the above rejection based on the Negro reference, and particularly with respect to the inherency of such heating and cooling. It is noted that claim 31 does not set forth any particular structure of a heater or cooling structure that serves to distinguish over the teachings of Negro.

Applicant's comments that Negro's conveyors can not be described as a "cooling conveyor" since Negro does not explicitly say that the conveyor is used for cooling are not persuasive, noting that as the coils are conveyed, they will inherently be cooled by the ambient air, as described in the above rejection based thereon. Applicant's further assertion that "[B]ecause there is no heat involved, cooling is anything but 'inherent'" are also not persuasive, noting (as set forth in the above rejection based on Negro) that the spirals will inherently heat due at least to the friction between the thread material and the winding tooling, and thus, once the formed spirals exit the winding machine, they will be inherently cooled at least to some degree by the ambient air.

Applicant's comments regarding the EMI and Okada references, as well as to the different (U.S. Pat. No. 4,874,279) Pfaffle reference, U.S. Pat. No. 5,890,862 to Spiel, the Marlon 2001 reference, and U.S. Pat. No.'s 4,382,586 to Reese, 3,944,049 to Graybill, or 6,000,897 to DesJarlais, or the "Operator's Manual for Renz Automatic Plastic Spiral Winding and Length Cutting Machine" are not considered relevant at this point, as no rejection based on

any of these references is outstanding in the case, though Examiner does note that most of these references are not of record in the present case, noting that the only art made of record in this case is the art cited on the IDS of 3/7/2006, the IDS of 4/21/04, and the 892 Notice of References Cited mailed 9/7/2005, none of which appear to cite the indicated Spiel, Reese, Graybill, or DesJarlais references.

Regarding Applicant's comment that Pfaffle's use of an "integral compact design clearly teaches away from the notion of using separate forming and binding machines with a transfer mechanism, such as a conveyor...", it is noted that Examiner does not agree that Pfaffle teaches away from using such a conveyor between the forming and binding machines since Pfaffle does not provide a teaching that the use of such a conveyor would be an undesirable thing to do. The mere fact that Pfaffle does not teach such a conveyor is not, in and of itself, a "teaching away" from using such a conveyor, i.e., is not a teaching that the use of such a conveyor is undesirable.

Regarding Applicant's comments regarding the "unexpected beneficial results" (last paragraph of page 27 of the remarks in the amendment of March 2006), it is firstly noted that Applicant has not provided clear, enabling, and clearly supported claim language relating to the cooling of the spirals that would define over the prior art, and it is further noted that, as mentioned previously, Applicant has not provided sufficient factual evidence regarding these "unexpected beneficial results" of Applicant's own invention (or of the asserted negative and problematic results of the Pfaffle reference). Examiner finally notes that the above 35 USC 102/103 art rejection based on Negro of new independent claim 31 (as well as many of its dependent claims) do not rely upon the heating and cooling features of the Pfaffle reference, and

as such, asserted negative and problematic results of the Pfaffle reference that Applicant asserts are related to these heating and cooling features are not relevant to those rejections.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on M-F, 6:30 a.m. to 4:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571).272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Erica E Cadugan
Primary Examiner
Art Unit 3722

eec
October 24, 2007